

In re Patent Application of:  
**ROBERT M. HERRIN**  
Serial No. 10/721,962  
Filing Date: 11/25/2003

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### Remarks

Claims 1-19 and 46-56 remain in the case. Claims 20-45 have been withdrawn.

Claims 1-19 and 48-56 (specifically claims 1, 8, 48, and 51) were rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 4, 8, 48, and 51 are herein amended to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner reminds the Applicant and the undersigned that while features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. Respectfully, the Examiner appears to have arbitrarily identified structural elements from the cited Tharpe '906 reference without thought as to whether or not the element can work together to provide the claimed invention. Indeed they cannot, as supported by the Declarations of Herrin and Tharpe previously presented.

The above referenced office action includes a Restriction of claims 46-47 with an understanding by the Examiner that they are directed to a non-elected invention. Based on the following claim comparison (independent apparatus Claim 1 versus independent apparatus Claim 46) which would appear to show that each claim includes the same structural elements and combinational relationships, the Applicant and the undersigned are concerned as to why the Examiner restricts these claims, and ask for the Restriction to be withdrawn or guidance in the way of an explanation as to where

Reference is made to the attached annotated edition of FIGS. 3, 4, and 10 (Informal Drawing Sheets 3/10, 4/10, and replacement sheet 6/10) presented for the convenience of the Examiner in analyzing independent claims 1 and 46 for both a determination as to whether a restriction is proper, and as an aid in better

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understanding the claimed invention. Elements in Claim 1 are presented in paragraphs A1 – F1, while those of Claim 26 are presented in paragraphs A46 – F46. Elements A and B are clearly illustrated in FIG. 3, while elements C-F are clearly illustrated in FIGS. 4 and 10, by way of example.

1. An apparatus comprising:

(A1) a platen 102 operable for moving between a first position 106 proximate and in spaced relation to a blank 200 and a second position 108 downstream therefrom, the platen 102 being biased against the blank 200 for a driving of the blank 200 downstream to the second position, the platen 102 having a guide plate 158 operable at a peripheral portion thereof for providing a compression surface 160;

(A46) a platen 102 operable for movement along a path therefor between a first position 106 and a second position 108;

(B1) a forming rail 114 positioned downstream the first position 106 for receiving the blank 200 moving against the forming rail for folding portions the blank 200, wherein a proximal portion 116 of the forming rail 114 partially folds peripheral portions 204 of the blank 200 and a distal portion 118 of the forming rail 114 secures the blank 200 into a partially formed tray 206, wherein the side walls 218 of the partially formed tray are fully formed, the distal portion 118 having a side folding rail portion 166 opposing the guide plate 158 for receiving the blank peripheral portions 204 therebetween;

(B46) a forming rail 114 positioned downstream the first position 106;

(C1) a first folding arm 120 movably positioned for biasing against an extended portion 208 of the partially formed tray 206 for a continued folding thereof, the first folding arm 120 positioned proximate the distal portion 118 of the forming rail 114 and downstream the proximal portion 116 thereof, wherein the first folding arm 120 is movable between a first position allowing the platen 102 to move thereby (see FIG. 4) along a path of the platen 102 to a position within the path (see FIG. 10) and generally perpendicular thereto;

(C46) a first folding arm 120 rotatable about an axis thereof, the first folding arm 120 positioned proximate a distal portion 118 of the forming rail 114 and downstream a proximal portion thereof, wherein the first folding arm 120 is movable between a position (see FIG. 4) for allowing the platen 102 to move

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thereby along the path to a position (see FIG. 10) within the path;

(D1) a compression plate **122** movably carried in spaced relation to the partially formed tray **206**;

(D46) a compression plate **122**;

(E1) a fixed plate **124** carried in spaced relation to the compression plate **122**, the fixed plate **124** having a surface **125** thereof generally parallel to the path of the platen **102**, the fixed plate **124** and the compression plate **122** forming a passage **126** therebetween; and

(E46) a fixed plate **124** carried in spaced relation to the compression plate **122**, the fixed plate **124** having a surface **125** thereof generally parallel to the path of the platen **102**, the fixed plate **124** and the compression plate **122** forming a passage **126** therebetween, wherein the compression plate **122** is moveable toward the fixed plate **124**; and

(F1) a second folding arm **128** movable through the passage **126** and positioned for biasing against the extended portion **238** of the partially formed tray **206** and for folding the extended portion **238** through the passage **126**, wherein the fixed plate **14** is positioned for guiding the extended portion **238** along the surface **125** of the fixed plate **124** onto a tray wall **212** for providing a fully formed tray **202**.

(F46) a second folding arm **128** rotatable about an axis thereof for movement through the passage **126**, the axis of the second folding arm **128** being generally perpendicular to the axis of the first folding arm **120**.

The amendments herein presented are intended to overcome the §112 rejection and do not affect the scope or breadth of the claims. The Restriction appears to be made in error based on the elements contained in the claims when compared to the claims being examined. In particular, the limitations of paragraph F46 would appear to overlap in scope and present an obvious variant to the movement of the second folding arm, as clearly supported by the specification described with reference to FIGS. 4 and 10, and as illustrated in the attached annotated informal drawings. Further, the utility is clearly maintained. In addition, the Examiner would appear to be inconsistent in arguing

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that there is separate utility such as folding more the side wall of et blank, when earlier the Examiner argues that claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. Retraction of the restriction is respectfully requested.

To support the concern for bias expressed by the examining group, and in support of arguments presented regarding nonobviousness based on a single reference and interpretation, two declarations were previously presented by declarants being people skilled in the art and experienced with the forming apparatus disclosed in the cited Tharpe '906 reference and the claimed invention. Each declarant deals with the Applicant at "arms length." Declarant Mark Kenyon expresses in his Declaration that a modification of the Tharpe '906 tray former was not an option as the forming elements making up the structure of the Applicants tray former and their relationship to each are very different. It was clear that a tray former different from that of Tharpe '906 was needed, and resulted in a purchase of the Applicant's tray former. Declarant Kenyon further supports a contradiction to the Examiner's interpretation of the teachings of Tharpe '906. Based on review of the apparatus described by the Tharpe '906 patent and the Herrin apparatus that is the subject of the above application, it was clear that a modification to the Tharpe '906 apparatus was not an option if his company wanted to have a tray former to form the double glued corner tray structure. It is Declarant Kenyon's opinion that the teachings of the Tharpe '906 do not provide sufficient guidance to make modifications that result in the apparatus of Herrin. Further, Declarant Lieffort expresses in his Declaration that attempts were made to modify this the Tharpe '906 apparatus to form the double glued corner style tray disclosed by the Applicant. Even with a "total redesign of the forming elements," he was unsuccessful in attempts to modify the apparatus described in the Tharpe '906 patent to provide the structure described by the Applicant. Based on these failed attempts to modify the Tharpe '906 apparatus, his company purchased the Applicant's apparatus. Declarant

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Lieffort states that it is very clear to him that the combination of elements used in the Applicant's apparatus are significantly different than those described in the Tharpe '906 apparatus. It appears to Declarant Lieffort that the Examiner has taken features described in the Tharpe '906 for one tray forming apparatus and determined that the Tharpe '906 patent would allow one of skill in the art to make the Applicant's apparatus with engineering choice, but in fact his experience with the Herrin apparatus and the Tharpe '906 apparatus would show otherwise. Changes to the apparatus disclosed in Tharpe '906 were made in an attempt to construct the Herrin apparatus. The changes could not provide the structure of the Herring apparatus, and could not be used to form the desired tray structure that the Herrin apparatus could form. He concludes that the teachings of the Tharpe '906 patent do not provide sufficient guidance to one skilled in the art to make modifications that result in the apparatus of the Applicant.

The Examiner is asked to consider the need for a *prima facie* case for obviousness. It is understood that while the Office has the initial burden of producing a factual basis for a rejection under §103, the Applicant is obliged to provide rebuttal with a showing of facts supporting the opposite conclusion. The arguments provided during prosecution of this application and the Declarations herein presented support a conclusion of non-obviousness. Respectfully, the Examiners must consider all the evidence anew, and an earlier conclusion should not be regarded as set in concrete, as would appear to have been happening based on identical restatements for the reason for the rejection.

The Examiner is also asked to consider the fact that those skilled in the art attempted, and failed to produce desirable results provided by the claimed invention using the teachings and specifically the embodiment described in the cited prior art should be sufficient evidence that the claimed invention is not obvious to those of skill in the art, as suggested in the office actions. An interpretation of the teachings of Tharpe '906 stating or at least implying that the innovations provided by the Applicant are

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simply a matter of engineering choice should be seen as carrying little weight in light of the evidence that those skilled in the art tried and failed to solve the same problem addressed by the Applicant, and later adopted the solution of the Applicant by purchasing a embodiment of his invention, the embodiment that is in fact the subject of the claims pending in this case.

As evidenced by the Declarations herein presented, commercial success resulted as a result of the claimed invention, not because of promotional efforts or a strong marketing effort directed to unclaimed features. Commercial success clearly resulted from features of the claimed invention, an invention that solved a problem and satisfied a need that was not able to be achieved by those skilled in the art.

Applicant asks that the Declarations of Jim Liefert and Mark Kenyon be entered along with those of Herrin and Tharpe previously presented not convincing because the Examiner felt the declarants presented bias even though they were acknowledged to be experts in the art. The Declarations of the Applicant (Robert M. Herrin) and Johnny Marion Tharpe (named co-inventor of the cited Tharpe '906 reference) were submitted in response to the non-final office action of 10/06/2005. Declarants Liefert and Kenyon have dealt with the Applicant at arms length. They represented companies regularly using tray forming machines and have specifically used the apparatus disclosed in Tharpe '906. The declarants are clearly skilled in the art. They attempted to modify the Tharpe '906 apparatus to that of the Applicants and failed in their attempts. Clearly, this shows good and sufficient reason why the declarations herein presented must be entered and considered.

To further aid the Examiner in his search efforts, known prior art has been reviewed and submitted in the attached Information Disclosure Statement. No single reference, nor combination of references, teaches or suggest the claimed invention of the Applicant.

Applicant further asks that this application be allowed based on the clear

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distinction of the claimed invention over known prior art, whether taken individually or in combination. This application is felt to be in a condition for allowance.

If the further prosecution of the application can be facilitated through a telephone or personal interview between the Examiner and the undersigned, the Examiner is requested to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,



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